

GP1731

**AMENDMENT TRANSMITTAL LETTER (Small Entity)**

Docket No.  
**20453/2**

Applicant(s): **Bertram Eichel**

Serial No.  
**09/943,144**

Filing Date  
**August 30, 2001**

Examiner  
**Walls, Dionne A.**

Group Art Unit  
**1731**

Invention: **Process and Apparatus For The Removal of Toxic Components Of Tobacco Smoke And The Standardization Of The Health Hazards Related To Those Components**

**TO THE ASSISTANT COMMISSIONER FOR PATENTS:**

Transmitted herewith is an amendment in the above-identified application.

- ☒ Small Entity status of this application has been established under 37 CFR 1.27 by a verified statement previously submitted.
- ☐ A verified statement to establish Small Entity status under 37 FR 1.27 is enclosed.

The fee has been calculated and is transmitted as shown below.

**CLAIMS AS AMENDED**

	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST # PREV. PAID FOR	NUMBER EXTRA CLAIMS PRESENT	RATE	TECHNOLOGY CENTER 1700	RECEIVED JAN 29 2003 ADDITIONAL FEE
TOTAL CLAIMS	25 -	42 =	0 x	\$9.00		\$0.00
INDEP. CLAIMS	1 -	5 =	0 x	\$40.00		\$0.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>						\$0.00
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$0.00

- ☒ No additional fee is required for amendment.
- ☐ Please charge Deposit Account No. \_\_\_\_\_ in the amount of \_\_\_\_\_  
A duplicate copy of this sheet is enclosed.
- ☐ A check in the amount of \_\_\_\_\_ to cover the filing fee is enclosed.
- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. **50-0369**  
A duplicate copy of this sheet is enclosed.
- ☒ Any additional filing fees required under 37 C.F.R. 1.16.
- ☐ Any patent application processing fees under 37 CFR 1.17.

Dated: **January 21, 2003**

*Signature*

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CC:

I certify that this document and fee is being deposited on January 21, 2003 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

*Michelle A. Phinney*  
*Signature of Person Mailing Correspondence*

**Michelle A. Phinney**

*Typed or Printed Name of Person Mailing Correspondence*



#6/13M  
1-30-03

Attorney's Docket 20453/2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**APPLICANT(S):** Bertram Eichel

**EXAMINER:** Walls, Dionne A.

**SERIAL NO.:** 09/943,144

**ART UNIT:** 1731

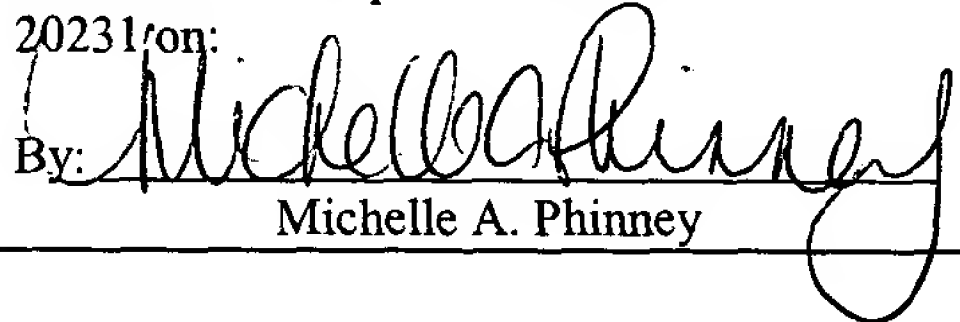
**FILED:** August 30, 2001

**CONF. NO.:** 8651

**FOR:** *Process and Apparatus For The Removal Of Toxic Components Of Tobacco Smoke  
And The Standardization Of The Health Hazards Related To Those Components*

**CERTIFICATE OF MAILING**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the Box Non-Fee Amendment, Commissioner for Patents, Washington D.C. 20231 on:

By:   
Michelle A. Phinney

Date: January 21, 2003

BOX NON-FEE AMENDMENT  
Commissioner for Patents  
Washington D.C. 20231

**RESPONSE TO RESTRICTION REQUIREMENT**

Sir:

This is being filed in response to the Office Action mailed from the U. S. Patent and Trademark Office on December 18, 2002 in the above-identified application. This response is believed to be timely filed, however, authorization is hereby given to charge Deposit Account No. 50-0369 in connection with any fees for extension of time that are necessary to permit entry of this response.

Please consider the remarks set forth herein below.

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**REMARKS**

In Paragraphs 1 and 2 of the pending Office Action, the Examiner set forth an election/restriction requirement. The Office Action restricts pending claims 1-42 as follows:

Group I is drawn to a filter for tobacco products, classified in class 131, subclass 334, currently embodied in claims 1-25;

Group II is drawn to a method of assessing the relative safety of tobacco products, classified in class 435, subclass 4+, currently embodied in claims 26-31;

Group III is drawn to a method of evaluating the adverse effects of tobacco precuts, classified in class 435, subclass 4+, currently embodied in claims 32-40;

Group IV is drawn to a method of marketing tobacco products, classified in class 705, subclass 500, currently embodied in claim 41; and

Group V is drawn to a method of assessing the long term effects of chronic use of tobacco, classified in class 435, subclass 4+, currently embodied in claim 42.

Applicants provisionally elect, with traverse, Group I. According to Section 803 of the M.P.E.P., restriction may properly be required between patentably distinct inventions if (1) the inventions are independent or distinct as claimed; and (2) there is a serious burden on the Examiner if restriction is not required. In this case, the entire patent system would be unnecessarily burdened with the additional application required and the duplicative work this restriction demand entails.

Specifically, Applicants respectfully submit that there will not be a serious burden on the Examiner if restriction between the claims is not required because regardless of the claims prosecuted, the field of search for each of the identified groups will substantially overlap, if not be identical to the other. A separate field of search is shown to exist only when one of the

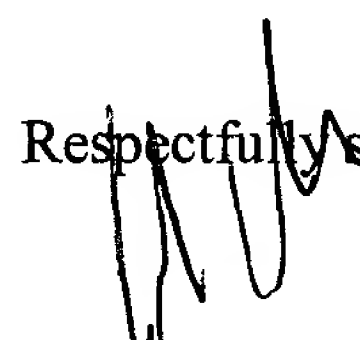
distinct subjects can be searched in places where no pertinent art to the other subject exists. In this case, however, there is no indication that a separate field of search is required for the distinct inventions. Thus, Applicants respectfully contend that there will not be a serious burden on the Examiner if restriction is not required.

Furthermore, it is well established that restriction is not mandatory merely because the subject matter of the claims may be separately classified. In the present application, since the claims are so closely related, the fields of search would necessarily be co-extensive. The fact that the apparatus and methods related to that apparatus may have acquired a separate status in the art, as stated by the Examiner, is not seen to be a material factor, at least insofar as the restriction requirement for the present invention is concerned. For these reasons, Applicant respectfully requests that the Examiner reconsider and withdraw the restriction requirement.

### CONCLUSION

The claims remaining within the application are believed to patentably distinguish over the prior art and to be in condition for allowance. Early and favorable consideration of this application is respectfully requested.

Respectfully submitted,



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Dated: January 21, 2003